

REMARKS

Claims 1-43 are pending in the above-identified patent application. Claims 1, 23, and 41 are independent.

In applicant's December 12, 2005, Reply to Final Office Action, applicant submitted its response to the examiner's §101 and §112 rejections. Since the examiner did not indicate in the December 30, 2005, Advisory Action whether the examiner had considered applicant's response and/or had withdrawn those rejections, applicant resubmits herein, for the examiner's convenience, applicant's response to the examiner's §101 and §112 rejections.

Claim Rejections – 35 U.S.C. §101

The examiner rejected claims 1-22 and 42 under 35 U.S.C. §101 on the ground that the claimed invention is allegedly directed to non-statutory subject matter.

Specifically, the examiner contended that, “[f]or a method to pass muster, the recited method must somehow apply, involve, use, or advance the technological arts. In the instance case, claim 1, only recites an abstract idea. The recited steps of merely displaying a list of vaguely defined potential other entities, receiving information from one entity to another entity and abstract display of potential other entities with whom the user may [or may not] have account does not apply, involve, or advance the technical arts” (page 2 of the Office Action). Applicant respectfully disagrees.

In the recent decision of *Ex Parte Lundgren* (Appeal No. 2003-2088), the majority of the Board of Patent Appeals and Interferences stated:

Our determination is that there is currently no judicially recognized separate “technological arts” test to determine patent eligible subject matter under §101. We decline to create one. Therefore, it is apparent that the Examiner's rejection cannot be sustained.

Thus, contrary to the examiner's position, under current patent law jurisprudence there is no requirement that a recited method in a claim apply, involve, or advance technical arts.

Notwithstanding that there is no requirement that a claim be directed to a technological art, applicant submits that in any event the method recited in claim 1 is in fact directed to a technological art. Amended claim 1 recites “automatically selecting from a list of entities

maintained by a first entity one or more entities that provide network-accessible accounts according to data associated with a user.” This feature is performed automatically, for example, by a CPU-based device, and thus this feature applies or involves technical arts, such as computer and automation technology arts.

Applicant thus traverses the examiner's rejections under 35 U.S.C. §101.

Claim Rejections – 35 U.S.C. §112

The examiner rejected claims 1-43 under 35 U.S.C. §112, 1st paragraph, as failing to comply with the written description requirement. Specifically, the examiner contended that “[t]he disclosure lacks clear written description in the description of how to determine a list of one or more other entities that provide network-accessible account being performed automatically, by a first entity or other entities. The disclosure also lacks description how to determine an undefined ‘potential other entities’.” (page 3 of the Office Action). Applicant respectfully disagrees.

A description of how applicant's method determines a list of one or more entities is provided in considerable detail in, among other places, FIG. 2, page 10, lines 7-14, and page 11, line 20 to page 14, line 14, of the originally filed application. For the examiner's convenience, reproduced below is an excerpt from the detailed description, appearing on page 12, lines 8-20, that discusses how lists of other entities are determined.

As described above, process 200 generates (216) a list of other institutions managing network-accessible accounts that might be owned by user 102 from personalization data about the customer and rule set stored in data table 126. This generation is done by categorizing all of the institutions with network-accessible accounts that are known to process 200 in data table 125 and applying rules to determine which of these institutions should be displayed to user 102. This personalization data can include automatically-collected data as well as data from the manual personalization test entered by user 102.

Process 200 generates (216) this list of institutions to present to user 102 by applying the rule set stored in data table 126 to the personalization data. These rules are stored in database 118 in section 122. The rules take the form of IF [condition] THEN [action]. The condition portion of these rules looks at the existence of some data in the personalization data for user 102. In some implementations, these rules are applied to the personalization data in data tables 130 and 132 in two or more iterations.

Further detail regarding the list determination procedure is provided throughout the specification of the originally filed application.

Additionally, regarding the alleged undefined "other entities", the specification makes it abundantly clear that other entities refer to institutes, organization, and the like. In one example the entities referred to are financial institutes that provide financial accounts (page 3, lines 29-31 of the originally filed application).

Applicant thus traverses the examiner's rejections under 35 U.S.C. §112, 1st paragraph.

Claim Rejections – 35 U.S.C. §112, 2nd paragraph

The examiner rejected claims 1, 23, and 41 under 35 U.S.C. §112, 2nd paragraph on the ground that "[c]laims 1, 23, 41 are vague and indefinite because it is unclear how to automatically determining a list of one or more other entities that provide network-accessible accounts" (Office Action, paragraph 6, page 3). The examiner further rejected claims 1, 23 and 41 under 35 U.S.C. §112, 2nd paragraph, as being incomplete for omitting essential steps, stating that, "[i]t is unclear how to automatically determine a list of one or more other entities that provide network-accessible accounts" (Office Action, paragraph 7, page 4).

Claims 1, 23 and 41 have been amended to replace the "automatically determining" language with the recitation "automatically selecting from a list of entities maintained by a first entity one or more entities that provide network-accessible accounts according to data associated with a user," or similar language. The amended language thus renders the examiner's comments regarding the language "automatically determining" moot. Applicant contends that the amended claims recite features that clearly and distinctly describe the subject matter that applicant regards as his invention, as required under 35 U.S.C. §112, 2nd paragraph.

The examiner also rejected claims 1, 23, and 41 under 35 U.S.C. §112, 2nd paragraph, on the ground that there is insufficient antecedent basis for the term "other entities" in the claims.

Claims 1, 23, and 41 no longer recite "other entities" and instead recite "one or more entities." The term "one or more entities" defined in the independent claim establishes a proper antecedent basis.

Applicant thus traverses the examiner's rejections under 35 U.S.C. §112, 2nd paragraph.

Claim Rejections – 35 U.S.C. §102

The examiner rejected claims 1-43 under 35 U.S.C. §102(e) as being unpatentable by U.S. Publication No. 2002/0194502 to Sheth et al.

Specifically, the examiner stated that “Sheth et al. disclose a system and method comprising: automatically determining, by a first entity (grantor) and using data associated with a user, a list of one or more other entities that provide network-accessible accounts (Host Server 1010)” (page 4 of the Office Action).

Applicant amended independent claim 1 to clarify that one or more entities, that provide network-accessible accounts, are automatically selected from a list of entities according to data associated with a user. Claim 1 was also amended to further clarify that at least one second entity is chosen from the automatically selected one or more entities. Support for these clarifications in the originally filed application is found, for example, at page 8, line 29, to page 9, line 9, page 10, lines 15-24, etc. Independent claims 23 and 41 were similarly amended. In addition, claims 7 and 26 were amended to clarify that the one or more entities are displayed as a sub-list of entities. Support for this clarification is found, for example, at page 8, line 29, to page 9, line 9 of the originally filed application. Additionally, claims 2, 7, 8, 9, 21, 22, 26, 27, 39 and 40 were amended for greater clarity and to make the language recited in these claims consistent with the language recited in the respective amended independent claims.

Applicant also added new claims 44 and 45 reciting the feature that automatically selecting from the list of entities includes applying rules to at least one of the data associated with the user and the list of entities. Support for this feature in the originally filed application is found, for example, in page 8, line 29 to page 9 line 9, and in page 12, line 8 to page 13, line 6 of the originally filed application.

Applicant's independent claim 1 thus recites a method that includes “automatically selecting from a list of entities maintained by a first entity one or more entities that provide network-accessible accounts according to data associated with a user.” Applicant's method enables a first entity, such as a financial institution with which a user has a web-accessible account, to select from a list of entities (e.g., other financial institutes) maintained by the first entity one or more entities with whom the user may possibly have accounts it may be able to access through a network. That automatic selection of the list of potential one or more entities is

determined using data associated with the user. For example, the user may provide data that includes the name and address of the user (page 11, lines 22-23 of the originally filed application). By identifying such one or more entities and presenting those selected entities to the user, the user may choose from the presented entities those entities with whom it has network-accessible accounts, and provide the first entity with access information for such accounts so that the user may access and manage its various accounts from a single platform.

As explained in applicant's previous responses to office actions relating to the above-identified application, Sheth discloses an information aggregation system through which a user can aggregate information from several sources and present the information uniformly on a single interface (page 1, paragraph 3). Sheth further describes that a user can populate the user's interface by selecting institutes/web-sites from an alphabetic list of such institutes/web-sites stored on a database 416, or by using a search function to find institutes/web-sites to add to the user's monitor (FIG. 8A, and paragraph 75 on page 6). But nowhere does Sheth describe that entities from that alphabetic list are automatically selected, and Sheth certainly does not describe an automatic selection of entities according to data provided by a user. So unlike applicant's claim 1, Sheth does not identify potential institutes and/or web-sites on the basis of user-specific data associated with that user, such as the user's name and address. Accordingly, Sheth does not disclose or suggest "automatically selecting from a list of entities maintained by a first entity one or more entities that provide network-accessible accounts according to data associated with a user," as required by applicant's claim 1.

The examiner also relies on paragraph 20 of Sheth as allegedly disclosing the features of applicant's independent claim 1. Sheth's paragraphs 19-20, as well as paragraphs 393-406 on pages 17-18, describe that Sheth's system allows users to create view pages and share those views with other users of the system by granting those other users visitation access codes (paragraphs 395-397 on page 17). Specifically, Sheth explains at paragraph 19 and then at paragraphs 404-405:

[0019] ... A grantor user creates one or more view pages, each of the view pages having a plurality of monitors therein. A unique visitation access code is assigned to each of a plurality of grantee users of the Internet information aggregation system. The grantor selectively obtains the visitation access codes from one or more of the grantees, and uses the

visitation access codes to selectively grant visitation access to one or more of the grantor's view pages to one or more of the grantees.

[0404] As indicated in block 2212, if the user is authorized to grant access, the grantor is permitted to proceed through the procedure for granting Visitation Access. The grantor is presented with a GUI for granting Visitation Access, such as the preferred embodiment shown in FIG. 14. As indicated in block 2216, the grantor enters the Visitation Access Code of a selected grantee. As mentioned above, the system assigns a Visitation Access Code to each user who has Visitation Access privileges. Upon receiving input for the grantee's Visitation Access Code, the routine determines whether the grantor has entered a correct Visitation Access Code 2220. If the grantor enters an incorrect Visitation Access Code, the routine displays an error message 2224 and/or prompts the grantor to reenter the Visitation Access Code. If the grantor enters a correct Visitation Access Code for a selected grantee, the routine displays a list of the grantor's existing views 2228. Every user of the Internet information aggregation system is assigned a unique Visitation Access Code. The assignment of the user's unique Visitation Access Code is preferably made during the enrollment process. The user's Visitation Access Code is part of the user's personal profile information and is stored on a database of the Internet information aggregation system. In a preferred embodiment, a user's Visitation Access Code can be changed by the user if desired.

[0405] As show in FIG. 15C, a grantor can preferably assign visitation access rights to a grantor in two ways. Access can be granted either at the view level whereby the grantor selects the views 20 to be given access to and sets the necessary permissions for the grantee. In this mode the grantee has access to all the information aggregated in the particular view(s) 20 to which he has been granted access. Alternatively, access can be granted on an individual account level. In this case, the grantee gets access only to those particular accounts for which he is given permission by the grantor. Depending on the mode selected for granting access 2222, a list of all the grantor's available views 2228, or a list of all the grantor's available accounts, is displayed 2230. Using the list, the grantor selects the views or accounts to which the grantee will be granted access.

Thus, it is the granting user who has to identify the grantee users to whom access will be granted by specifying the grantee users' unique visitation access codes. Sheth's system does not itself provide the grantor user with a list of grantee users or with their visitation access codes. Indeed, to ensure that the grantor user has selected legitimate grantee users, Sheth's system determines, upon receiving the grantor user's input, whether the grantor user has entered correct visitation access codes (see paragraph 404). At no point does Sheth describe that its system automatically selects grantees from a global list of grantees according to data associated with the user. Accordingly, unlike the applicant's independent claim 1, Sheth does not disclose or suggest "automatically selecting from a list of entities maintained by a first entity one or more

entities that provide network-accessible accounts according to data associated with a user," as required by applicant's claim 1.

Since Sheth does not disclose at least the feature of "automatically selecting from a list of entities maintained by a first entity one or more entities that provide network-accessible accounts according to data associated with a user," applicant's independent claim 1 is therefore patentable over the cited art.

Claims 2-22, 42 and 44 depend from independent claim 1 and are therefore patentable for at least the same reasons as independent claim 1.

Claims 23 and 41 recite "automatically select from a list of entities maintained by the first entity one or more entities that provide network-accessible accounts according to the data associated with the user," or similar language. For reasons similar to those provided with respect to independent claim 1, at least this feature is not disclosed by the cited art. Accordingly, independent claims 23 and 41 are patentable over the cited art. Claims 24-40, 43 and 45 depend from independent claim 23, and are patentable over the cited art for at least the same reasons as independent claim 23.

Additionally, as noted above, the examiner rejected claim 5 under 35 U.S.C. §102(e) as being unpatentable by Sheth.

Applicant's claim 5 recites "[t]he method of claim 2 wherein determining the personalization data further comprises: providing a personalization test to the user; and analyzing one or more answers of the user from the personalization test." As explained at page 5, lines 1-7 of the originally filed application:

As described above, process 200 can also provide (212) a manual personalization test to user 102. This test asks user 102 multiple choice or "fill in the blank" questions to collect data about the user so that process 200 can generate (216) a list of institutions that might manage accounts owned by user 102. These questions include questions such as what are your hobbies, what is your profession, who is your employer, what is your employer's stock symbol, what is your age, and who is your Internet Service Provider (ISP). The answers to the questions are then collected (214) and stored by program 116 in database 118 in data table 132.

The examiner relied on paragraph 45-58 of Sheth as allegedly disclosing the above-noted features of claim 5. Applicant respectfully disagrees.

Paragraphs 45-58 of Sheth provide a system overview (at paragraphs 46-47), a description of the Sheth's user interface (paragraphs 48-54), and a description of how a user can create a view page on Sheth's information aggregation system (paragraphs 55-57). While these paragraphs describe some user interaction with the Sheth system (for example, Sheth describes at paragraph 56 "[a] new view page 20 is created by selection 'Add/Delete Views' from the 'Options' feature 110 of the view page 20"), Sheth does not describe in these paragraphs, or elsewhere, that a user is presented with a personalize test and/or that answers from such a test are analyzed to facilitate the selection of entities to present to the user. Accordingly, Sheth does not disclose or suggest "wherein determining the personalization data further comprises: providing a personalization test to the user; and analyzing one or more answers of the user from the personalization test," as required by applicant's claim 5.

Claim 24 recites "the program comprises further instructions that further configure the server to: provide a personalization test to the user; and analyze one or more answers of the user from the personalization test." For at least similar reasons as those provided with respect to claim 5, at least this feature is not disclosed by the cited art. Claim 24, therefore, is patentable over the cited art. Claim 25 depends from claim 24 and is therefore patentable for at least the same reasons as claim 24.

Furthermore, as noted above, the examiner also rejected claim 9 under 35 U.S.C. §102(e) as being unpatentable by Sheth.

Applicant's claim 9 recites "[t]he method of claim 8 wherein determining one or more entities that have a relation to the first entity further comprises: identifying the one or more entities that have the relation to the first entity; and ordering the one or more entities based on the relation."

The examiner relied on paragraph 20 of Sheth as allegedly disclosing the above-noted features of claim 9. Applicant respectfully disagrees.

As applicant explained above, Sheth's paragraphs 19-20, as well as paragraphs 393-405, describe that a grantor user can use visitation access codes to selectively grant visitation access to one or more of the grantor's view pages to one or more grantees. As noted above, Sheth describes at paragraph 19:

A grantor user creates one or more view pages, each of the view pages having a plurality of monitors therein. A unique visitation access code is assigned to each of a plurality of grantee users of the Internet information aggregation system. The grantor selectively obtains the visitation access codes from one or more of the grantees, and uses the visitation access codes to selectively grant visitation access to one or more of the grantor's view pages to one or more of the grantees.

Sheth does not, however, describe that its system creates or orders a list of grantees. Sheth, therefore, does not disclose or suggest “wherein determining one or more entities that have a relation to the first entity further comprises: identifying the one or more entities that have the relation to the first entity; and ordering the one or more entities based on the relation,” as required by applicant’s claim 9. Accordingly, claim 9 is patentable over the cited art.

Claim 27 recites “wherein the program comprises further instructions that further configure the server to: identify one or more entities in the list whose business has a relation to the business of the first entity; and prioritize the identified one or more entities in the display of the sub-list.” For at least similar reasons as those provided with respect to claim 9, at least this feature is not disclosed by the cited art. Accordingly, applicant’s claim 27 is patentable over the cited art.

Claims 28 and 29 depend from applicant’s claim 27 and are therefore patentable for at least the same reasons as claim 27.

It is believed that all the rejections and/or objections raised by the examiner have been addressed.

All of the dependent claims are patentable for at least the reasons for which the claims on which they depend are patentable.

Canceled claims, if any, have been canceled without prejudice or disclaimer. Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the examiner’s positions with respect to that claim or other claims.

Applicant : McDonough et al.
Serial No. : 10/606,904
Filed : June 26, 2003
Page : 18 of 18

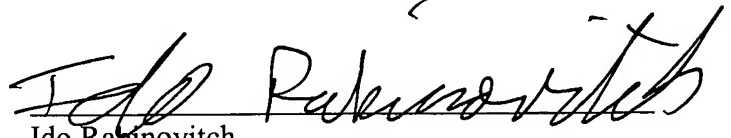
Attorney's Docket No.: 08575-074001

Enclosed is a Request for Continued Examination and a Petition for Three Month Extension of Time, along with the required fees of \$790 and \$1020. Also enclosed is a check for \$100 for excess claim fees. Please apply any other charges or credits to deposit account 06-1050, referencing attorney docket 08575-074001.

Respectfully submitted,

Date:

March 2, 2006


Ido Rabinovitch
Reg. No. L0080

Fish & Richardson P.C.
Telephone: (617) 542-5070
Facsimile: (617) 542-8906